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10/688,075	10/17/2003	Thomas Huber	2050.085US1	8165
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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				THOMAS, JASON M
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/688,075	HUBER ET AL.	
	Examiner	Art Unit	
	Jason Thomas	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 October 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 17 October 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/21/08.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak, U.S. Pat. No. 6,006,257 (hereinafter Slezak) in view of Morrison, U.S. Pat. No. 5,815,671 (hereinafter Morrison), Emura et al., U.S. Pre- Grant No. 2002/0129371 A1 (hereinafter Emura) and Bacon et al., U.S. Pat. No. 6,212,278 B1 (hereinafter Bacon).

Regarding claim 1: Slezak discloses a method of presenting advertising in a subscriber broadcast system, the method comprising:

offering an upgraded advertising service (see [cols. 3-4, ll. 63-4], [col. 8, ll. 21-32] for offering upgraded advertising services);

receiving subscriptions to said upgraded advertising service (see [cols. 3-4, ll. 63-4], [col. 8, ll. 21-32], [col. 10, ll. 59-60], [col. 11, ll. 14-17] where selecting a full, half, or no charge subscribing for an upgraded advertising service); and receiving a plurality of video feeds including a plurality of advertisements (see [figs 4], [col. 5, ll. 11-16], [col. 5, ll. 42-54], [col. 11, ll. 52-62] for system which receives a plurality of video feeds which include secondary programming such as advertisements).

Slezak is silent regarding: delivering set top box computer program code to a plurality of set top boxes, each set top box being associated with an upgraded advertising service subscriber; providing indicators for at least two advertisements of said plurality of advertisements wherein said indicators include a priority level and a category for a corresponding advertisement; and broadcasting a video signal comprising program content, said plurality of advertisements, and said indicators for at least two advertisements of said plurality of advertisements to a plurality of set top boxes, wherein the set top box computer program code is to select one of the at least two advertisements based on said indicators.

Morrison teaches: providing indicators for at least two advertisements of said plurality of advertisements wherein said indicators include a category for a corresponding advertisement (see [tbl.1], [col. 3, ll. 32-55] for providing category data); and broadcasting a video signal comprising program content, said plurality of advertisements, and said indicators for at least two advertisements of said

plurality of advertisements to a plurality of set top boxes, wherein the set top box computer program code is to select one of the at least two advertisements based on said indicators (see [figs. 4a-4d], [figs 3a-3b], [tbl. 1], [col. 3, ll. 16-63], [claim 4] for broadcasting a video signal comprising said data to a plurality of receivers whereby instructions in the processor compare and select advertisements based on indicators).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide: advertisement indicators which include corresponding advertisement data for insertion determination; and broadcasted video signals containing said content fitted for targeted advertising, as taught in Morrison, when creating a subscriber broadcast system, as taught in Slezak, because this is a well known way of targeting specific subscriber groups (see Morrison [abstract]).

Morrison however does not explicitly teach including a priority level in said indicator.

Emura teaches assigning priority levels to advertisement content as in the form of importance indicators (see [151], [550], [551]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an indication of the priority of the content, as taught in Emura, when providing other information such as category information, as taught in Morrison, because priority information can allow content of a specific priority to be transferred according to a current need (see [551]).

Bacon teaches delivering set top box computer program code to a plurality of set top boxes (see [abstract] for a reprogrammable subscriber terminal capable of receiving downloads of new program code from the headend).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to enable a set top box to receive new code, as taught in Bacon, when providing code designed to provide subscribers with upgraded advertising service, as taught in Slezak, because it's advantageous to be able to reprogram subscriber terminals to change parameters or add new features (see [col. 1, ll. 59-63]).

Regarding claim 2: The combined teachings of Slezak, in view of Morrison, Emura and Bacon, teach further comprising: receiving a request for an advertising category from at least one subscriber of said plurality of subscribers (see [col. 3-4, ll. 63-4], [col. 8, ll. 24-32] for selecting a category of advertisements).

Regarding claim 4: Slezak does not explicitly teach downloading an advertisement and corresponding indicator to local storage of a set top box.

Morrison teaches downloading an advertisement and corresponding indicator to local storage of a set top box (see [fig. 2, 28], [col. 3, ll. 16-34] where primary and secondary materials are downloaded to the receiver's storage for subsequent retrieval).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide the ability to download advertisement contents

to the receiver storage, as taught in Morrison, when delivering a subscriber broadcast system, as taught in Slezak, because the user may not wish to view the incoming materials the moment they are received (see Morrison [col. 1, ll. 57-67]).

Regarding claim 5: The combined teachings of Slezak, in view of Morrison, Emura and Bacon, teach further comprising: selecting said plurality of advertisements based upon demographic characteristics of said plurality of set top boxes (see Slezak: [title], [col. 1, ll. 31-51], [col. 2, ll. 15-18] for selecting secondary programming such as advertisements based upon the viewer demographics).

Regarding claim 6: The combined teachings of Slezak, in view of Morrison, Emura and Bacon, teach a method for displaying user selected advertising in a subscriber broadcast system, the method comprising:
requesting a category of advertisement from a plurality of advertisement categories, the category being selected by a subscriber (see [col. 3-4, ll. 63-4], [col. 8, ll. 24-32] for selecting a category of advertisements);
receiving a video signal comprising program content, a standard advertisement, and an advertisement indicator, wherein said advertisement indicator indicates a priority level and a category value for an advertisement corresponding to the category (see Morrison: [tbl. 1], [col. 3, ll. 16-55] for program, ads, indicators and category information; Emura: [151], [550], [551] for priority indicators);

determining if said standard advertisement may be replaced with an upgraded advertisement (see Slezak: [cols. 3-4, ll. 63-4], [col. 8, ll. 21-32]); accessing upgraded advertisement content if it is determined that said standard advertisement may be replaced with an upgraded advertisement; and displaying said upgraded advertisement content if it is determined that said standard advertisement may be replaced with an upgraded advertisement (see Slezak [cols. 3-4, ll. 63-48] where additional advertising content is added or removed based on user determination and displayed to the user).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak, in view of Morrison, Emura, Bacon and Eldering et al., U.S. Pre- Grant Pub. 2002/0083443 A1 (hereinafter Eldering).

Regarding claim 3: Slezak does not explicitly teach broadcasting an advertising indicator that includes a network address for an advertisement that can be accessed across a network.

Eldering teaches broadcasting an advertising indicator that can be retrieved using a network address (see [abstract], [6], [31], [67]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include a broadcast a network address as a form of pointer or advertising indicator, as taught in Eldering, when broadcasting said indicators, as taught in Slezak, because this would allow for more space to be reserved for storing non-advertisement contents in local storage.

4. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak in view of Emura and Dudkiewicz et al., U.S. Pat. No. 6,973,665 B2 (hereinafter Dudkiewicz).

Regarding claims 7: Slezak discloses an upgraded advertising production system comprising: a processor (see [col. 7, ll. 26-40] for a cpu); an advertisement detector receiving a video feed comprising program content and advertising (see [cols. 3-4, ll. 63-13] where it inherently is capable of having a detector to detect an advertising period in a video feed in that it is able to control the amount of advertising displayed); a channel multiplexer that receives said program content, at least one advertisement and that formats said program content, said advertisement (see [fig. 10], [col. 3, ll. 29-32], [col. 6, ll. 25-47], [col. 10, ll. 52-66]); and a transmitter that transmits said program content, said advertisement (see [fig. 4, 96], [col. 7, ll. 54-65], [col. 11, ll. 52-67]) but does not teach using advertisement indicators or wherein said advertisement indicator includes a priority level and category for a corresponding advertisement.

Dudkiewicz teaches using programming indicators which include category indicators to describe the program and an editor that can create, modify, and delete metadata containing indicator information for at least one programming indicator associated with the programming contained in said video feed (see [cols. 13-14, ll. 66-36]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide the ability to modify programming indicators, as

taught in Dudkiewicz, when delivering programming, in the form of advertisements with the ability to target, as taught in Slezak, because this provides a means for users with proper access to add, delete or change descriptive information to better describe the programming content (see [cols. 13-14, ll. 66-36]).

Dudkiewicz however does not explicitly teach including a priority level as an indicator.

Emura teaches assigning priority levels to advertisement content as in the form of importance indicators (see [151], [550], [551]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an indication of the priority of the content, as taught in Emura, when providing other information such as category information, as taught in Dudkiewicz, because priority information can allow programming of high importance to be delivered to the viewer in a more effective manner (see [551]).

Regarding claims 14: Slezak discloses an upgraded advertising production system comprising: processing means (see [col. 7, ll. 26-40] for a cpu); means for detecting an advertising period in a video feed (see [cols. 3-4, ll. 63-13] where it inherently is capable of detecting an advertising period in a video feed in that it is able to control the amount of advertising displayed); multiplexer means that receive said edited video feed and accesses advertising content and that formats said edited video feed and said advertising content for transmission

(see [fig. 10], [col. 3, ll. 29-32], [col. 6, ll. 25-47], [col. 10, ll. 52-66]); and transmission means that transmits said edited video feed and said advertising content (see [fig. 4, 96], [col. 7, ll. 54-65], [col. 11, ll. 52-67]).

Slezak does not explicitly disclose an advertisement indicator which is used associated with the advertisement.

Dudkiewicz teaches using programming indicators which include category indicators to describe the program and an editor that can create, modify, and delete metadata containing indicator information for at least one programming indicator associated with the programming contained in said video feed (see [cols. 13-14, ll. 66-36]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide the ability to modify programming indicators, as taught in Dudkiewicz, when delivering programming, in the form of advertisements with the ability to target, as taught in Slezak, because this provides a means for users with proper access to add, delete or change descriptive information to better describe the programming content (see [cols. 13-14, ll. 66-36]).

Dudkiewicz however does not explicitly teach including a priority level as an indicator.

Emura teaches assigning priority levels to advertisement content as in the form of importance indicators (see [151], [550], [551]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an indication of the priority of the content, as taught in Emura, when providing other information such as category information, as taught in Dudkiewicz, because priority information can allow programming of high importance to be delivered to the viewer in a more effective manner (see [551]).

5. Claims 8, 9, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak in view of Morrison and Emura.

Regarding claims 8 and 15: Slezak discloses a set top box that selectively displays upgraded advertising comprising: a processor (see [col. 8, ll. 5-10] for a cpu); an audio/video processor that outputs audio and video signals to a display unit (see [col. 3, ll. 45-52], [col. 4, ll. 45-48], [col. 8, ll. 1-17]); and a tuner controlled by said processor that receives a video input (see [col. 8, ll. 13-14] for an NTSC tuner) but does not teach receiving a video input comprising program content wherein the program content comprises a first advertisement, a first advertisement indicator, a second advertisement, and a second advertisement indicator wherein said first advertisement indicator and said second advertisement indicator both identify a category of the advertisement and a priority level; a first computer program code operating on said processor that detects said first advertisement indicator and said second advertisement indicator and compares the category of said first advertisement and the category of said second advertisement to a stored category value and that compares the

priority level of said first advertisement with the priority level of said second advertisement and that selects said first advertisement unless the category of said second advertisement corresponds to said stored category value and the priority level of said second advertisement is greater than or equal to said priority level of said first advertisement; and second computer program code that provides said first advertisement to said audio/video processor if said first advertisement is selected and that accesses and provides said second advertisement to said audio/video processor if said second advertisement is selected.

Morrison teaches a tuner controlled by said processor that receives a video input comprising program content wherein the program content comprises at least a first advertisement, a first advertisement indicator, a second advertisement, and a second advertisement indicator wherein said first advertisement indicator and said second advertisement indicator include a category of the advertisement (see [tbl.1], [fig. 2 item 12], [col. 3, ll. 16-55], [col. 5, ll. 1-14] see where at multiple ads are received each having indicators (which would include first and second indicators) which are matched with the categories as provided in [tbl. 1] to be inserted when appropriate); a first computer program code operating on said processor that detects said first advertisement indicator and said second advertisement indicator and compares the category of said first advertisement and the category of said second advertisement to a stored category value and that selects said first advertisement

unless the category of said second advertisement is in agreement with said stored category value (see [fig. 5], [col. 3, ll. 16-55], [cols. 5-6, ll. 67-5] where [figs. 5 and 6] lays out portions of a program process which selects said advertisement to be inserted); second computer program code that provides said first advertisement to said audio/video processor if said first advertisement is selected and that accesses and provides said second advertisement to said audio/video processor if said second advertisement is selected (see [fig. 2], [fig. 6], [col. 4, ll. 2-13], [cols. 5-6, ll. 67-5] for a device which has portions of programming which enables it to select based on category, and then to display contents audio and video through insertion).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide: a tuner which is controllable; advertisement indicators which contain characteristics of the incoming advertisement contents; and code that is able to make use of the incoming indicator information by comparing said information, as taught in Morrison, when delivering a subscriber broadcast system, as taught in Slezak, because a tuner must be controlled by a processing device and it is common for such a controlled tuner to be capable of receiving contents which contain coded items such as indicators and said tuner (see [col. 3, ll. 5-15]), furthermore it would be expected that some program is necessary to detect and process said indicators in order to create some order amongst the incoming material based on included category and priority information (see Morrison [col. 1, ll. 62-67], [col. 5, ll. 67 - col. 6, ll. 5]).

Morrison however does not explicitly teach including a priority level in said indicator.

Emura teaches assigning priority levels to advertisement content as in the form of importance indicators (see [151], [550], [551]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an indication of the priority of the content, as taught in Emura, when providing a way to compare descriptive information such as category information, as taught in Morrison, because priority information can allow content of a specific priority to be transferred according to a current need (see [551]).

Regarding claim 9: The combined teachings of Slezak, in view of Morrison and Emura, teach further comprising computer program code that processes a user input and stores said stored category value in said set top box (see Morrison: [fig. 2, 28], [col. 3, ll. 16-34] where primary and secondary materials are downloaded to the receiver's storage for subsequent retrieval

Regarding claim 12: The combined teachings of Slezak, in view of Morrison and Emura, teach wherein said second computer program code further comprises code that acquires said second advertisement across a network (see Slezak: [fig. 1], [col. 4, ll. 49-58], [col. 5, ll. 1-10], [col. 8, ll. 43-52] for acquiring secondary programming across a network through the where computer program code inherently is comprises a plurality of code or computer program code

routines that work together to provide functionality to a system such as that of a set top box or PC).

Regarding claim 13: The combined teachings of Slezak, in view of Morrison and Emura, teach a video combiner that combines a portion of said first advertisement with a portion of said second advertisement (see Slezak: [fig. 10], [col. 10, ll. 61-64]).

6. Claims 10, 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak, in view of Morrison, Emura and Wachob, U.S. Pat. No. 5,155,591 (hereinafter Wachob).

Regarding claim 10: Slezak does not teach computer program code that recognizes a remote control input as being specific to one user and selects said stored category value from a plurality of stored category values based upon an identifier of said one user.

Wachob teaches means implicit of executable instructions that recognize a remote control input as being specific to one user and selects said stored category value from a plurality of stored category values based upon an identifier of said one user (see [figs. 2 & 4], [col. 1, ll. 48-55], [col. 2, ll. 10-23], [col. 2, ll. 37-42]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide a means for identifying multiple users, as taught in Wachob, when delivering a subscriber broadcast system, as taught in Slezak, because it is common for multiple viewers with differing preference to live in the

same location and use the same display apparatus (see Wachob [col. 2, ll. 13-17], [col. 2, ll. 37-40]).

Regarding claim 11: Slezak does not disclose a second computer program code further comprises code that adjusts said tuner to receive said second advertisement.

Wachob teaches control functions (programming code) that further comprise adjusting said tuner to receive said second advertisement (see [col. 4, ll. 41-55], [col. 6, ll. 50-67]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to adjust a tuner to tune to another channel, as taught in Wachob, to view an alternate advertisement, as taught in Slezak, because such methods are well known to those skilled in the art (see [col. 4, ll. 45-49]).

Regarding claim 16: Slezak discloses a method of operating a subscriber broadcast system comprising: defining a plurality of advertising categories (see [cols. 3-4, ll. 63-14], [col. 8, ll. 18-42] for a plurality of advertising categories such as none, some or many); receiving user requests for said advertising categories (see [cols. 3-4, ll. 63-14], [col. 8, ll. 18-42]);

Slezak does not teach transmitting program content and advertisements with advertisement indicators

Morrison however teaches transmitting program content and advertisements with indicators allowing selection of advertisements at a set top

box (see [col. 3, ll. 16-55]; and determining a count of advertisements viewed in each category of said plurality of advertising categories (see [col. 3, ll. 62-63]).

Morrison does not teach assigning priority levels to advertisement content or creating a billing statement reflecting said count of advertisements in each category. Dudkiewicz however does not explicitly teach including a priority level as an indicator.

Emura teaches assigning priority levels to advertisement content as in the form of importance indicators (see [151], [550], [551]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an indication of the priority of the content, as taught in Emura, when providing other information such as category information, as taught in Dudkiewicz, because priority information can allow programming of high importance to be delivered to the viewer in a more effective manner (see [551]).

Wachob teaches providing billing data, from accurate commercial tracking, which reflects said count of advertisements (see [col. 2, ll. 43-48], [col. 3, ll. 48-51], [col. 9, ll. 15-19], [col. 10, ll. 27-28]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide billing data, as taught in Wachob, when delivering a subscriber broadcast system, as taught in Morrison, because this would be expected, when alternating which commercials are displayed based on

user data, to provide market research functions and enable accurate billing of advertisers for the commercials presented to the users (see [col. 2, ll. 43-48]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Thomas whose telephone number is (571) 270-5080. The examiner can normally be reached on Mon. - Thurs., 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. Thomas

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2623